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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/765,043	01/28/2004	Tomoko Maruyama	204552031700	9599
7590 Barry E. Bretschneider Morrison & Foerster LLP Suite 300 1650 Tysons Boulevard McLean, VA 22102				
06/08/2010				
EXAMINER				
CHEEMA, UMAR				
ART UNIT		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/765,043

Applicant(s)

MARUYAMA ET AL.

Examiner

UMAR CHEEMA

Art Unit

2444

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 March 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/CD)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. This action is in response to the Amendment filed on 03/02/2010. Claims 1-15 are pending with claims 1, 11, and 12 as being independent claims. Claims 1-6, 8-9, and 11-15 have been further amended.
2. Applicant's arguments, see Remarks, page 1, with respect to Claims 1, 11 and 12 are rejected under 35 U.S.C. 112, second paragraph have been fully considered and are persuasive. Claims 1, 11 and 12 are rejected under 35 U.S.C. 112, second paragraph rejection has been withdrawn.

Response to Arguments

3. Applicant's arguments with respect to claims 1-15 have been considered but are in moot of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1, 11, and 12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicant's amendment, "an input accepting section for accepting input by a user to designate a sender e-mail address which is distinct from a sending station address specifying the network scanner

device,” are not supported by the specification in such a way that one of the ordinary skill person in the art would have recognized the invention. Applicant is respectfully advised to point out from specification to provide appropriate support for such limitations in future response.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
5. Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Itoh (US 2001/0021037 A1) in view of Partial Translations of JP 2000-215124 A (Partial) and further in view of Takayama (US Pub. No. 2002/0133564).
6. **Regarding claim 1**, Itoh discloses the invention as claimed a network scanner device for transmitting image data through a network (see abstract, pg. 1, par. 0015-0016) comprising: a reading section for scanning a document to obtain image data (see abstract, pg. 1, par. 0018), a first setting section for setting up a recipient address to which the image data is to be transmitted (pg. 1, par. 0019), a second setting section for setting up the inputted sender e-mail address in

place of the sending station address when the sender e-mail address is inputted via the input accepting section (see pg. 1, par. 0020, fig. 10- where IP address is the address of the sender instead of the sending location address; also see par. 0059, 0146; sender and IP address of the transmitting destination), and a transmission control section for carrying out control for (a) adding to the image data the sender e-mail address set by the second setting section when the sender e-mail address is set up in place of the sending station address, and (see pg. 1, par. 0017, pg. 6, par. 0146, fig. 10, pg. 5, par. 0111) and transmitting the image data to the recipient address set by the first setting section (see pg. 1, par. 0022) (b) transmitting the image data with the sending station address and not the sender e-mail address when the sender e-mail address is not set up in place of the sending station address.

7. Itoh discloses substantial features of the invention as claimed above for the given reason however does not explicitly disclose wherein setting up the inputted sender's e-mail address is sender's address instead of sending station address and the sender e-mail address is set up in place of the sending station address, and transmitting the image data with the sending station address and not the sender e-mail address when the sender e-mail address is not set up in place of the sending station address.

8. In the same field of invention Partial discloses wherein setting up the inputted sender's e-mail address is sender's address instead of sending station address and the sender e-mail address is set up in place of the sending station address, and transmitting the image data with the sending station address and not the sender e-mail address when the sender e-mail address is not set up in place of the sending station address (see par. [0039, 0045, 0053-0055], figures 10, 1, 11, 17 and the details associated).

9. It would have been obvious to one of the ordinary skill person in the art of networking to combine the teaching of Itoh and Partial for a network scanner device for transmitting data over a network. Motivation for doing so would have been that this method provides users more options to monitor and transmit image data over a network.

10. Although Itoh discloses the substantial features of the applicant's claimed invention, Itoh fails to expressly disclose wherein an input accepting section for accepting input by a user to designate a sender e-mail address which is distinct from a sending station address specifying the network scanner device; and where sender e-mail address is inputted via the input accepting section. Nevertheless, an input accepting section for accepting input by a user to designate a sender e-mail address which is distinct from a sending station address specifying the network scanner device; and where sender e-mail address is inputted via the input accepting section, were well known in the art at the time of present invention.

11. In analogous teaching Takayama discloses wherein an input accepting section for accepting input by a user to designate a sender e-mail address which is distinct from a sending station address specifying the network scanner device; and where sender e-mail address is inputted via the input accepting section (see at least par. [0005, 0041, 0043, 0098]; wherein a **sending/receiving sections accept such as a selecting input from the operational section and electronic mail which both are distinct from each others in a scanner device communication network).**

12. Thus, given the teaching of Takayama, it would have been obvious to one of the ordinary skill person in the art of networking to combine the teaching of Itoh into Takayama for an

inputting section in network scanner device for inputting data in network scanning device as well known in the art.

13. **Regarding claim 2**, Itoh discloses a network scanner device as claimed in claim 1, further comprising a one-touch setting section (see pg. 1, par. 0021) for setting up the recipient address and the sender e-mail address simultaneously (see pg. 1, par. 0021, pg. 2, par. 0050).

14. **Regarding claim 3**, Itoh discloses a network scanner device as claimed in claim 2, wherein the one-touch setting section (see pg. 1, par. 0021) carries out setting of the recipient address and the sender e-mail address, in accordance with instructions by the sender (see pg. 2, par. 0050).

15. **Regarding claim 4**, Itoh discloses a network scanner device as claimed in claim 2, further comprising a display section that is capable of displaying information including the recipient address and the sender e-mail address (see fig. 1, pg. 2, par. 0049, pg. 3, par. 0070, pg. 6, par. 0146).

16. **Regarding claim 5**, Itoh discloses a network scanner device as claimed in claim 1, further comprising a storage section in which candidates of recipient addresses associated with each sender e-mail address are stored (see pg. 3, par. 0074), wherein, on setting of the sender e-mail address, the recipient address is chosen from candidates of recipient addresses associated with the sender e-mail address (see fig. 10, pg. 6, par. 0146).

17. **Regarding claim 6**, Itoh discloses a network scanner device as claimed in claim 1, further comprising a storage section in which sender e-mail addresses associated with IDs representing users are stored (see pg. 2, par. 0054), wherein the sender e-mail address is automatically set up in accordance with an inputted ID (see pg. 3, par. 0073).

18. **Regarding claim 7**, Itoh discloses a network scanner device as claimed in claim 6, further comprising an ID input prompting section for making a display that prompts input of an ID representing a user, as a condition for start of operations of the device (see fig. 1, pg. 2, par. 0049, pg. 3, par. 0073).
19. **Regarding claim 8**, Itoh teaches a network scanner device as claimed in claim 1, further comprising an operation panel by which information including the recipient address and the sender e-mail address is inputted or chosen (see abstract, pg. 1, par. 0019).
20. **Regarding claim 9**, Itoh discloses a network scanner device as claimed in claim 1, wherein information including the recipient address and the sender e-mail address can be inputted through the network (see pg. 1, par. 0055).
21. **Regarding claim 10**, Itoh discloses a network scanner device as claimed in claim 1, wherein the sending station address specifying the device is included in contents of a text of mail to which the image data is added (see pg. 5, par. 0132).
22. **Regarding claim 11**, Itoh discloses the invention as claimed a network scanner device for transmitting image data through a network (see abstract, pg. 1, par. 0015-0016), comprising: image memory in which image data is stored (see fig. 2, pg. 2, par. 0056), a first setting section for setting up a recipient address to which the image data is to be transmitted (see pg. 1, par. 0019), a second setting section for setting up the inputted sender e-mail address in place of the sending station address when the sender e-mail address is inputted via the input accepting section (see pg. 1, par. 0020, pg. 6, par. 0146, fig. 10 -- where IP address is the address of the sender instead of the sending location address; also see par. 0059, 0146; sender and IP address of the transmitting destination), and a transmission control section for carrying out control for (a)

adding to the image data the sender e-mail address set by the second setting section when the sender e-mail address is set up in place of the sending station address, and (see pg. 1, par. 0017, pg. 6, par. 0146, fig. 10, pg. 5, par. 0111) and transmitting the image data to the recipient address set by the first setting section (see pg. 1, par. 0022) (b) transmitting the image data with the sending station address and not the sender e-mail address when the sender e-mail address is not set up in place of the sending station address.

23. Itoh discloses substantial features of the invention as claimed above for the given reason however does not explicitly disclose wherein setting up the inputted sender's e-mail address is sender's address instead of sending station address and the sender e-mail address is set up in place of the sending station address, and transmitting the image data with the sending station address and not the sender e-mail address when the sender e-mail address is not set up in place of the sending station address.

24. In the same field of invention Partial discloses wherein setting up the inputted sender's e-mail address is sender's address instead of sending station address and the sender e-mail address is set up in place of the sending station address, and transmitting the image data with the sending station address and not the sender e-mail address when the sender e-mail address is not set up in place of the sending station address (see par. [0039, 0045, 0053-0055], figures 10, 1, 11, 17 and the details associated).

25. It would have been obvious to one of the ordinary skill person in the art of networking to combine the teaching of Itoh and Partial for a network scanner device for transmitting data over a network. Motivation for doing so would have been that this method provides users more options to monitor and transmit image data over a network.

26. Although Itoh discloses the substantial features of the applicant's claimed invention, Itoh fails to expressly disclose wherein an input accepting section for accepting input by a user to designate a sender e-mail address which is distinct from a sending station address specifying the network scanner device; and where sender e-mail address is inputted via the input accepting section. Nevertheless, an input accepting section for accepting input by a user to designate a sender e-mail address which is distinct from a sending station address specifying the network scanner device; and where sender e-mail address is inputted via the input accepting section, were well known in the art at the time of present invention.

27. In analogous teaching Takayama discloses wherein an input accepting section for accepting input by a user to designate a sender e-mail address which is distinct from a sending station address specifying the network scanner device; and where sender e-mail address is inputted via the input accepting section (see at least par. [0005, 0041, 0043, 0098]; wherein a **sending/receiving sections accept such as a selecting input from the operational section and electronic mail which both are distinct from each others in a scanner device communication network**).

28. Thus, given the teaching of Takayama, it would have been obvious to one of the ordinary skill person in the art of networking to combine the teaching of Itoh into Takayama for an inputting section in network scanner device for inputting data in network scanning device as well known in the art.

29. **Regarding claim 12**, Itoh discloses the invention as claimed an image data transmitting method of a network scanner device (see abstract, pg. 1, par. 0015-0016) which attaches image data to electronic mail and transmits the image data through a network (see pg. 1, par. 0112-

0113), comprising steps of: scanning a plurality of documents to obtain the image data (see pg. 1, par. 0002), setting first and second recipient addresses to which respective first and second parts of the image data are to be transmitted (see pg. 1, par. 0019), setting the inputted sender e-mail address in place of the sending station address when the sender e-mail address is inputted via the input accepting section (see pg. 1, par. 0020, pg. 6, par. 0146, fig. 10 -- where IP address is the address of the sender instead of the sending location address; also see par. 0059, 0146; sender and IP address of the transmitting destination), adding the set sender e-mail address to the first part of the image data in place of the sending station address and transmitting the image data to the first recipient address through the networks (see pg. 1, par. 0112-0113, pg. 7, par. 0174, pg. 5, par. 0111).

30. Itoh discloses substantial features of the invention as claimed above for the given reason however does not explicitly disclose wherein setting up the inputted sender's e-mail address is sender's address instead of sending station address and the sender e-mail address is set up in place of the sending station address, and transmitting the image data with the sending station address and not the sender e-mail address when the sender e-mail address is not set up in place of the sending station address.

31. In the same field of invention Partial discloses wherein setting up the inputted sender's e-mail address is sender's address instead of sending station address and the sender e-mail address is set up in place of the sending station address, and transmitting the image data with the sending station address and not the sender e-mail address when the sender e-mail address is not set up in place of the sending station address (see par. [0039, 0045, 0053-0055], figures 10, 1, 11, 17 and the details associated).

32. It would have been obvious to one of the ordinary skill person in the art of networking to combine the teaching of Itoh and Partial for a network scanner device for transmitting data over a network. Motivation for doing so would have been that this method provides users more options to monitor and transmit image data over a network.

33. Although Itoh discloses the substantial features of the applicant's claimed invention, Itoh fails to expressly disclose wherein an input accepting section for accepting input by a user to designate a sender e-mail address which is distinct from a sending station address specifying the network scanner device; and where sender e-mail address is inputted via the input accepting section. Nevertheless, an input accepting section for accepting input by a user to designate a sender e-mail address which is distinct from a sending station address specifying the network scanner device; and where sender e-mail address is inputted via the input accepting section, were well known in the art at the time of present invention.

34. In analogous teaching Takayama discloses wherein an input accepting section for accepting input by a user to designate a sender e-mail address which is distinct from a sending station address specifying the network scanner device; and where sender e-mail address is inputted via the input accepting section (see at least par. [0005, 0041, 0043, 0098]; wherein a **sending/receiving sections accept such as a selecting input from the operational section and electronic mail which both are distinct from each others in a scanner device communication network**).

35. Thus, given the teaching of Takayama, it would have been obvious to one of the ordinary skill person in the art of networking to combine the teaching of Itoh into Takayama for an

inputting section in network scanner device for inputting data in network scanning device as well known in the art.

36. **Regarding claim 13**, Itoh discloses an image data transmitting method as claimed in Claim 12, wherein the step of scanning a document and obtaining image data (see pg. 1, par. 0015), the step of setting the recipient address to which the image data is to be transmitted (see pg. 1, par. 0019), and the step of setting the sender e-mail address representing the sender in place of the sending station address specifying the device are carried out in an altered sequence (see pg. 1, par. 0020, pg. 4, par. 0090, pg.7, par. 0164).

37. **Regarding claim 14**, Itoh discloses a network scanner device as claimed in claim 1, wherein the designation of the sender e-mail address is carried out by a user selection from addresses stored in the network scanner device in advance (see par. 0059, 0146; sender and IP address of the transmitting destination).

38. **Regarding claim 15**, Itoh discloses a network scanner device as claimed in claim 1, wherein the designation of the sender e-mail address is carried out by an input of the sender e-mail address by a user (see par. 0059, 0146, 0106; figure 7, inputs the IP address as the transmitting destination).

Conclusion

39. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to UMAR CHEEMA whose telephone number is (571)270-3037. The examiner can normally be reached on M-F 8:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Jr. Vaughn can be reached on 571-272-3922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/U. C./

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Art Unit: 2444

Examiner, Art Unit 2444

/William C. Vaughn, Jr./

Supervisory Patent Examiner, Art Unit 2444